

PATENT
Atty. Dkt. No. AVAN/001110

REMARKS

This is intended as a full and complete response to the Office Action dated January 11, 2005, having a shortened statutory period for response set to expire on April 11, 2006. Claims 1-19 have been examined. The Examiner rejected claims 1 and 12 under 35 U.S.C. § 102(e) as being anticipated by Miao (US 2004/0184696). The Examiner rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by Koh (US 2005/0030623). The Examiner rejected claims 1 and 12 are rejected under 35 U.S.C. § 102(a) as being unpatentable over Wu (US 6,134,358). The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Bergmann (US 5,930,028). The Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being obvious over Wu in view of Shani (US 6,259,834).

Claim Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1 and 12 under 35 U.S.C. § 102(e) as being anticipated by Miao. The Examiner rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by Koh. The Examiner rejected claims 1 and 12 under 35 U.S.C. § 102(a) as being unpatentable over Wu. The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Bergmann. Applicants have cancelled claims 1 and 12, thereby obviating the rejection.

Claim Rejections Under 35 U.S.C. § 103

The Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being obvious over Wu in view of Shani. The Examiner states that Wu discloses all the limitations of claim 19 except for showing a pair of switches connected in series. As such, the Examiner attempts to supplement this missing limitation with Shani. According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two switches disclosed by Wu, as taught by Shani, for the purpose of interconnecting a larger amount of input and output waveguides.

Applicants respectfully traverse the rejection on grounds that the Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claim 19 includes the limitation of a first re-configurable channel dropping de-multiplexer and a second re-configurable channel dropping de-

PATENT

Atty. Dkt. No. AVAN/001110

multiplexer, wherein an input of the second re-configurable channel dropping de-multiplexer is coupled to a multiple-channel output of the first re-configurable channel dropping de-multiplexer. Shani does not disclose this limitation. Rather, Shani merely discloses a CLOS network that is configured to connect a plurality of input waveguides to a plurality of output waveguides via a plurality of subnetworks. Additionally, Wu does not disclose this limitation as admitted by the Examiner on page 6 of the Office Action and therefore Wu fails to cure the deficiencies of Shani.

Furthermore, to establish a *prima facie* case of obviousness, the examiner must *particularly* identify any suggestion, teaching or motivation from *within* the references to combine the references (emphasis added). See In Re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). As admitted by the Examiner, Wu does not disclose a pair of switches connected in series. As such, Wu fails to provide any motivation to connect a pair of switches in series. Moreover, Shani merely discloses a CLOS network configured to connect a plurality of input waveguides to a plurality of output waveguides. Thus, Shani also fails to provide any suggestion, teaching or motivation from *within* Shani to combine the references. Finally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As set forth above, both Wu and Shani fail to suggest the desirability of the combination that results in a cascaded re-configurable system having two or more re-configurable channel dropping de-multiplexers, as recited in claim 19.

Thus, the Examiner failed to establish *prima facie* case of obviousness. As a result, the combination of Wu and Shani fails to render claim 19 obvious. Applicants therefore submit that claim 19 is in condition for allowance and respectfully request withdrawal of the § 103(a) rejection. Additionally, since new claims 35 and 36 depend from claim 19, they are allowable for at least the same reasons as claim 19.

Allowable Subject Matter

The Examiner indicated that claim 18 is allowed. Applicants appreciate allowance of claim 18.

The Examiner objected to claims 2-11 and 13-17 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of

PATENT
Atty. Dkr. No. AVAN/001110

the base claim and intervening claims. In response, Applicants have rewritten claims 2-11 and 13-17 as new claims 20-34. Therefore, Applicants believe that new claims 20-34 are in condition for allowance and respectfully request the same.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the case is in condition for allowance. If the Examiner has any questions, please contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,



Walter C. Grollitsch
Registration No. 48,678
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants

Page 9

455734_1